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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,094	09/19/2003	Graeme R. Middleton	014208.1630 (93-03-012)	8989
35005	7590	04/10/2008	EXAMINER	
BAKER BOTTS L.L.P.			JARRETT, SCOTT L	
2001 ROSS AVENUE, 6TH FLOOR				
DALLAS, TX 75201-2980				
			ART UNIT	PAPER NUMBER
			3623	
			NOTIFICATION DATE	DELIVERY MODE
			04/10/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail2@bakerbotts.com
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Office Action Summary	Application No. 10/666,094	Applicant(s) MIDDLETON, GRAEME R.	
	Examiner SCOTT L. JARRETT	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's submission filed September 19, 2003. Currently Claims 1-20 are pending.

Title

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System and Method For Determining Which Information Technology Initiative to Fund Based on an Assessed Strategic Value.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 9, 13 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 7, 13 and 18, Claims 7, 13 and 18 recite the limitation "the initiative" in Claims 1, 11 and 16 respectively. There is insufficient antecedent basis for this limitation in the claim.

Examiner requests clarification as to which one of the plurality of initiatives the applicant's is intended to refer. Does the method step apply a weighting factor

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individually for each category and for each of the initiatives or are the weights applied to the categories and are applied equally to all initiatives?

Examiner interpreted the claim to read that any (one or more) of the previous categories has a weight applied to it for the purposes of examination.

Appropriate correction required.

Regarding Claim 9, Claim 9 recites the limitation "wherein technical impact and risk impact overlays" in Claim 1. There is insufficient antecedent basis for this limitation in the claim.

Examiner interpreted the claim to read further comprising a technical impact and risk impact overlays for the purposes of examination.

Appropriate correction required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Remenyi, Dan et al., The Effective Measurement and Management of IT costs and benefits (2001).

Regarding Claims 1, 11 and 16 Remenyi et al. teach a system and method of assessing information technology needs in a business comprising (Chapter 10, Pages 20—208; Figures 10.1, 10.2, 13.3):

- gathering information associated with the operation of a business in categories (groups, sets, classes, folders, etc.) pertaining to information technologies desired to be implemented (Section 10.3, Page 210; Figures 4.1, 10.1, 10.2);

- applying strategic value ratings (scores, rankings, weights, metrics, measures, etc.) to each criteria in the categories (Page 207; Section 10.3, Page 210);

- categorizing initiatives (projects, programs, work, application, system, etc.) so that like initiatives are assessed against each other (Paragraph 2, Page 34; Page 207; Bullets 1-6, Page 208; Figures 4.1, 10.1, 10.2);

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- determining which initiatives are to be funding in accordance with the applied strategic value ratings (i.e. which project to invest; agreement to proceed; Number 3, Page 269; Last Paragraph, 271; Figure 13.4; Figure 10.6, Item 1.5).

IS selection system			
Indicates the 10 most relevant factors with an x.			
Strategic value		Operational value	Risk assessment
Industry attractiveness		Administration improvement	New technology x
Internal value chain	x	Legislative requirements	New application x
Industry value chain	x		Application size x
Offensive	x	Architectural value	Market damage x
Defensive	x	Operating system	
		Comms. infrastructure	
Critical value		Languages	
Expense control			
Asset reduction		Investment value	
Equipment utilisation		Payback	x
Sales increase		NPV/PI	x
Production enhancement		IRR	
Waste minimisation			

Figure 10.1: Selecting the decision variables

Selected criteria	Weighting	System 1		System 2		System 3	
		Score	Value	Score	Value	Score	Value
Internal value chain	8	5	40	4	32	2	16
Industry value chain	9	4	36	4	36	5	45
Offensive	10	3	30	4	40	5	50
Defensive	7	2	14	4	28	2	14
Payback	9	5	45	4	36	5	45
NPV/PI	9	4	36	4	36	5	45
New technology	-8	3	-24	2	-16	1	-8
New application	-5	3	-15	2	-10	2	-10
Application size	-7	2	-14	5	-35	2	-14
Market damage	-6	5	-30	5	-30	0	0
			118		117		163

Figure 10.2: Weighted criteria with scores for three competing information systems

10.2 Five steps to evaluation

There are five steps involved in an overview evaluation:

- 1 Select the criteria;
- 2 Associate weights to each criterion;
- 3 Score systems in terms of how they satisfy the criteria;
- 4 Calculate a system's rating by multiplying each score by the weight and then summing to a total.
- 5 Select the system with the greatest total score.

Figure 1: Section 10.2, Page 207

Regarding Claims 2, 12 and 17 Remenyi et al. teach a system and method for assessing IT further comprising applying an approval filter to each criteria of the categories (required return, etc.; Section 2.14-2.16, Pages 281-282; Figure 13.10).

Regarding Claim 3 Remenyi et al. teach an IT assessment system and method further comprising applying the strategic value rating in response to an affirmative approval filter (Number 3, Page 269; Last Paragraph, 271; Figure 13.4; Figure 10.6, Item 1.5).

Regarding Claims 4, 14 and 19 Remenyi et al. teach an IT assessment system and method further comprising calculating a strategic value assessment for each initiative from the strategic value ratings (Page 207; Figures 10.2, 10.2).

Regarding Claim 5 Remenyi et al. teach an IT assessment system and method further comprising establishing funding for an initiative with the highest strategic value assessment (Number 5, Page 207).

Regarding Claims 6, 15 and 20 Remenyi et al. teach an IT assessment system and method further comprising (Page 207; Section 10.3, Page 210; Figures 10.1, 10.2):

- comparing the strategic value assessments between two initiatives; and
- prioritizing (ranking) the first initiative with respect to the second initiative in response to the comparison.

Regarding Claims 7, 13 and 18 Remenyi et al. teach an IT assessment system and method further comprising applying a weight factor to each category pertaining to an initiative (Section 10.3, Page 210; Figures 10.1, 10.2).

Regarding Claim 8 Remenyi et al. teach an IT assessment method and system wherein the categories include strategic positioning, financial impact, intellectual assets, or business drivers associated with the business (Bullets 1-6, Page 208; Section 4.6, Page 66; Figures 4.1, 10.1, 10.2).

It is noted that the labels used to describe the various categories an IT initiatives merely represents non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited

method steps would be performed the same regardless of the specific labels used to describe the various IT initiatives categories. Further, the structural elements remain the same regardless of the specific labels used to describe the various IT initiatives categories. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* 2106.

Regarding Claim 9 Remenyi et al. teach an IT assessment method and system further comprising technical and risk impact overlays (levels, categories, criteria, information, measures, etc.) affect the application of the strategic value ratings (Chapter 8, Pages 129, 131; Bullets 1-6, Page 208; Number 1.13, Page 279; Figures 4.1, 13.6).

Regarding Claim 10 Remenyi et al. teach an IT assessment method and system wherein the initiatives are categorized according to whether an initiative transforms, grows, provide technical advantage or involves a technology refresh (Chapter 4.6, Page 64; Figure 4.1).

It is noted that the labels used to describe the various categories an IT initiatives merely represents non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific labels used to

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describe the various IT initiatives categories. Further, the structural elements remain the same regardless of the specific labels used to describe the various IT initiatives categories. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Cimral et al., U.S. Patent No. 6,578,004, teach a system and method for assessing information technology needs in a business comprising scoring/rating, and comparing IT projects/initiatives investments.

- Vellante et al., U.S. Patent Publication No. 2002/0069102, teach a system and method for assessing information technology needs in a business comprising evaluating IT investments within a business.

- Bacon, The Use of Decision Criteria in Selecting Information Systems/Technology Investments (1992), teach the well known assessment/evaluation of information technology needs in a business comprising selecting and pursuing (i.e. funding) IT initiatives/projects from a plurality of competing initiatives (investment decision, IT capital budgeting, justification) based on a plurality of investment financial and non-financial criteria such as NPV, IRR, strategic match, and competitive advantage.

- Mirani et al., Making Promises (1993), teach a method of assessing information technology needs in a business comprising gathering and analyzing a plurality of data associated with information technology initiatives and determining which initiatives are to be approved and funded in accordance with the decision criteria (e.g. strategic value).

- King et al., Information technology investment evaluation (1997), teach a method for assessing information technology needs in a business by analyzing/evaluating IT project/initiative alternatives in order to determine which initiatives to approve/fund.

- Grover, Corporate Strategy and IT Investments (1998), teach a method for justifying and prioritizing IT investments (funding of IT projects/initiatives) comprising assessing information technology needs in a business including gathering and analyzing a plurality of information associated to a plurality of IT initiatives and categorizing/classifying, scoring, ranking and prioritizing the IT initiatives.

- Stoiber, Maximizing IT Investments (1999), teaches an information technology investment methodology wherein IT projects are assessed, scored and selected/funded based on the analysis of a plurality of investment criteria (e.g. strategic value).

- May, Value Made Visible (2001), teach an information technology valuation/assessment method comprising scoring and comparing a plurality of IT investment alternatives using a plurality of strategic value measures (EVA, EVS, Real Options, etc.).

- Parker et al, Information Economics (1988), teach an old and very well known method for assessing information technology business needs comprising gathering and analyzing a plurality of information pertaining to IT initiatives, scoring (weighted and un-weighted), ranking and selecting IT initiatives for funding/approval.

- Mooney et al., A Process Oriented Framework for Assessing the Business Value of Information Technology (1996), teach a method for assessing information

technology needs in a business comprising categorizing IT initiatives, assessing/evaluating the value and impact of IT initiatives as well as ranking/scoring/comparing IT initiatives.

- Remenyi et al., Outcomes and benefits (2001), teach a system and method for approving/funding a selected subset of information technology initiatives from a group of alternative initiatives comprising scoring, ranking and comparing IT initiatives using a plurality of criteria (approval filters; ROI, payback, NPV, risk, etc.).

- Taylor, James, The Project Management Workshop (2001), teaches a method for evaluating information technology investment alternatives (initiatives) in a business wherein IT alternatives are scored and ranked as part of the investment (i.e. funding and approval) process.

- Grembergen, Information Technology Evaluation Methods & Management (2001), teach a method for assessing and selecting IT initiatives in a business for funding approval (i.e. IT investment decision making process) wherein IT initiatives are classified, scored and prioritized using a plurality of investment criteria.

- Fisher, Information economics (1995), teach a very well known method for determining which information technology initiatives to approve/fund (i.e. invest in) wherein the initiatives are evaluated/assessed (scored, ranked, prioritized) against a plurality of criteria (risk, economic impact, payback, ROI, etc).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is

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(571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hafiz Tariq can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/
Primary Examiner, Art Unit 3623